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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,088	03/12/2004	Shinya Haraguchi		8524

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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,088

Applicant(s)

HARAGUCHI, SHINYA

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/04/05 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on November 4, 2005. In the
5 amendment, claim 5 was amended. Currently, claims 5-9 remain in the examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

10 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the
15 enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re claim 5, amended claim 5 is unclear as to where (at a portable terminal or a host center) a particular step of the claim is occurring.

20 In Examiner's understanding of the process, in claim 5,

Line 6, "sending" - occurs at the portable terminal - sending from the terminal to the host.

Line 11, "receiving" - occurs at the portable terminal - the terminal receives an authentication request from the host.

Line 15, "authenticating" - occurs at the portable terminal. It is unclear what the
25 amended section, "and wirelessly transmitted to sad host center;" means.

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Line 18, "sending" – occurs at the portable terminal - sending from the terminal to the host.

Line 21, "receiving" – occurs at the portable terminal – receiving at the terminal from the host.

5 Line 24, "updating" – occurs at the portable terminal.

Line 26, "wirelessly receiving" – receiving notification of completion of update from the host according to the amended claim. However, as in line 24, the updating occurs at the terminal.

Accordingly, amended claim 5, particularly in lines 26-28 would cause enablement
10 problem since it is unclear where updating of the balance occurs – at the portable terminal or the host.

4. Claims 6-9 are rejected under 35 U.S.C. 112, first paragraph, as being dependent on claim 5.

For action on the merits, however, the Examiner interprets the claim 5 without lines 26-
15 28, which at least would allow the Examiner to understand the method being claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 5, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al. (US 5,714,741) in view of Davis et al. (US 6,311,167, hereinafter "Davis").

Re claims 5 and 6, Pieterse teaches a method and the apparatus for processing data in a portable terminal 13 having an interface 1 for connecting with an integrated circuit (IC) card (11)

5 (see abstract; col. 2, lines 37+; col. 4, lines 3+). The device allows users to consummate financial transaction (col. 1, lines 26+) where the users are required to enter identification information (col. 1, lines 39+). The identification number such as PIN number can be either entered or stored in the interface device or in the IC card (col. 5, line 62 – col. 6, line 8). The card information such as remaining balance is updated (col. 6, line 66 – col. 7, line 13; col. 10,
10 lines 1-13). As shown in figure 6, the interface device and the host (or the secure module) communicate in asynchronous fashion (meaning that one sends the command, and the other acknowledges and responds to the command).

Pieters, however, fails to specifically teach or fairly suggest that the portable terminal is a pager. And the portable terminal and the host communicates in wireless manner.

15 Davis discloses a portable 2-way terminal for consummating financial transaction (see abstract; col. 1, lines 65+), wherein the portable terminal is a cellular phone or a pager (col. 1, lines 30+;) or a pager including a telephone interface (col. 4, lines 13+; see figure 1). As the title of the patent indicates, various portable terminals communicate with the host in wireless manner.

20 In view of Davis' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify such smart-card transaction system designed for a telephone so that it could be adapted for a pager. Portable terminal includes a various

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embodiments such as cellular phone, PDA, various notebooks, and a pager. Transactional system designed for a cellular phone can be obviously modified to function on other similar devices. Therefore, such modification would have been an obvious extension as suggested by Davis, well within one ordinary skill in the art.

- 5 7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al. (US 5,714,741) as modified by Davis et al. (US 6,311,167) as applied to claim 5, and further in view of Zuppich (US 6,213,392, hereinafter "Zuppich"). The teachings of Pieterse modified by Davis have been discussed above.

Pieters/Davis, however, fail to specifically teach or fairly suggest the result of writing
10 operation is checked for error condition, which includes producing a buzzer sound.

Zuppich teaches a smart card and smart card interface system (see abstract), comprising, among other things, a buzzer (col. 6, lines 33+). The audible buzzer is activated in error condition, which includes write command (see table 6, and various other tables).

In view of Zuppich's teaching, it would have been obvious to an ordinary skill in the art
15 at the time the invention was made to employ well-known error-handling routine including an audible sound to the teachings of Pieters/Davis in order to let the users know the result of operation in user-friendly manner. Use of alerting means (i.e, blinking LED or buzzer sound) when the operations are not successfully performed is generally known in the art. Such feature can be particularly useful when the card interface and remote device interact in asynchronous
20 manner in that one device has to receive or acknowledged d of the other device. Accordingly, incorporating user-alerting or user-prompting means such as a buzzer so that users can fix the error condition would have been an obvious expedient, well within one ordinary skill in the art.

Response to Arguments

8. Applicant's amended claims and remarks filed on November 4, 2005 have been carefully reviewed and considered. Claim 5 was amended so that now it recites the method of updating the balance in the IC card in wireless manner, albeit use of the terminal.

5 Applicant's arguments with respect to the amended claims further clarifying the claims have been considered but are moot in view of the new ground(s) of rejection. Examiner also notes that the Davis patent was used in previous Office Action.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
20 however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The fax

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number directly to the Examiner is (571)273-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
January 19, 2006